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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 10/648,187 | 08/27/2003 | Toshiaki Takenaka | 43890-629 | 3489 |

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| EXAMINER | |
|---|---|
| ARBES, CARL J | |
| **ART UNIT** | **PAPER NUMBER** |
| 3729 | |

DATE MAILED: 04/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/648,187 | TAKENAKA ET AL. | |
| | Examiner | Art Unit | |
| | C. J. Arbes | 3729 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *27 August 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *16-37* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *16-37* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on 8/27/2003 is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☒ Certified copies of the priority documents have been received in Application No. 09/928,966.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *herreto*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Claims 16- 37 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling,.critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976).. One of the issues in this application revolves around the compressibility or lack thereof of the substrate (Cf.. Claim 15 ff) vis a vis Pat No 6,528,733 B2 by Takenaka et al; hereinafter Takenaka et al (on which there will be given a obviousness double patenting rejection hereinbelow). That is on page 14 of the instant specification Applicants disclose or perhaps allude to an "incompressible substrate" . It appears that such a substrate is composed of ... a woven or non-woven fabric and thermosetting e.g. epoxy, resin , based on inorganic material or aromatic polyamide and this composite is cured by heating. According to Applicants' specification on page 17 one can use non-woven fabric of an aromatic fiber wherein a thermosetting epoxy resin is impregnated therein. According to Applicants' disclosure on page 13 of the specification the incompressible substrate has more strength than a prepreg sheet and also is less deformed .than the sheet. Even in Applicants' exemplary embodiments Applicants do not provide enough detail of the fraction of thermosetting resin (Cf page 31), the degree of tacticity of the thermosetting material at a given temperature, the compressive strength, the amount and sizes of the "organic or inorganic material powder or fiber " Cf page 37 They do not disclose the composition of the " fiber aggregate " (Page 37) nor of the non-woven fabric or woven fabric (Cf. also page 37) Applicants merely state that the composite can be a non-woven fabric of aromatic polyimide fiber and thermosetting resin (Cf. pg 37). Applicants have not

disclosed sufficient parameters which would enable a POSITA to make and use the claimed invention and hence have failed to satisfy their burden under 35 U.S.C. 112 (1st Para).

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 16-37 are further rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 16-29 of U.S. Patent No. 6,528,733 B2. Although the conflicting claims are not identical, they are not patentably distinct from each other because the limitations recited in claims 16-29 of Pat No 6,528,733 B2 taken with the ordinary skill of a POSITA would make claims 16-37 of the instant Application obvious under the legal standard.

Any inquiry concerning this communication should be directed to C. J. Arbes at telephone number 571-272-4563.

C. J. Arbes
Primary Examiner
Art Unit 3729